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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20

Application Number: 08/947,435

Filing Date: October 08, 1997

Appellant(s): FERGUSON ET AL.

Caudle, Penny L., Reg. No. 46,607

For Appellants

MAILED

EXAMINER'S ANSWER

MAY 08 2001

Technology Center 2100

This is in response to appellant's brief on appeal filed February 21, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The Appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellants' statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellants' brief includes a statement that claims 1-28, 30-51, and 53-83 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

5,625,818	Zarmer et al	04/29/97
5,628,003	Fujisawa et al	05/06/97
5,727,175	Malone et al	03/10/98

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, and 51 rejected under 35 U.S.C. 103(a) as being unpatentable over Zarmer et al. US Patent 5,625,818.

Claims 3-10 are rejected under U.S.C. 103(a) as being unpatentable over Zarmer et al. US Patent 5,625,818 in view of Fujisawa et al. US Patent 5,628,003.

Claims 11-28 and 36-46 are rejected under U.S.C. 103(a) as being unpatentable over Zarmer et al. and Fujisawa et al. U.S. Patent 5,628,003 in view of Malone et al. U.S. Patent 5,727,175. This rejection is set forth in prior office action, Paper No. 17.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarmer et al (US 5,625,818), hereafter Zarmer.

With respect to claim 1, importing a document with a first format into a collection or documents ... (**column 6, lines 19-40**), the collection of documents is organized ...

according to a hierarchy of electronic folders storing the document in a memory location (**column 7, lines 18-27, column 12, lines 41-48, and column 18, 17-23**), automatically extracting attribute data from the document (**column 18, lines 24-34**), generating a data structure for the document (**column 23. Lines 40-51 and column 24, 48-63**), the data structure contains attribute data in a second format independent from the first format (**column 24, lines 6-18 and column 4, lines 41-49**), and linking the imported document to a first electronic folder (**column 6, lines 12-15 and lines 35-40**). Zarmer did not teach the data structure is stored and maintained in memory separate from the imported document and the attribute data in the data structure matches a set of predefined criteria corresponding to the first electronic folder," but it would have been obvious at the time the invention was made to one having ordinary skill in the art of data structures and attribute data to have a set of predefined criteria because the information in the data structure is arranged a certain way in the computer memory with the attributes in the data structure being those of files marked as hidden, read-only, and archive.

With respect to claim 2, optically scanning a paper-based document ... (**column 4, lines 27-37 and lines 38-55**).

Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarmer in view of Fujisawa et al (5,628,003), hereafter Fujisawa.

With respect to claims 3 and 9, Zarmer did not teach, the first format is an image format. Fujisawa teaches this in **column 7, lines 13-23**. It would have been obvious at the time the invention was made to a one having ordinary skill in the art of first formats to have an image format and to combine Zarmer's document with a first format with

Fujisawa's first format being an image because many word processing programs have the ability to import the text and graphics from other file formats.

With respect to claims 4 and 6, Zarmer did not teach, the first format is a text format. Fujisawa teaches this in **column 1, lines 63-67 and column 2, lines 1-5**. It would have been obvious at the time the invention was made to one having ordinary skill in the art of formats to have a text format and to combine Zarmer's collection of documents with Fujisawa's first format being a text format because importing is a type of file conversion with word processing programs having the ability to import text from several file formats.

With respect to claim 5, Zarmer did not teach, importing an electronic document.

Fujisawa teaches this in **column 1, lines 30-38**. It would have been obvious at the time the invention was made to one having ordinary skill in the art of importing documents to have a electronic document and to combine Zarmer's collection of documents with Fujisawa's document importing because an electronic document has the ability to have text and graphics from several file formats when being loaded from a format other than the application program's native format.

With respect to claim 7, Zarmer nor Fujisawa teaches, the document is a word processing document, but it would have been obvious to one having ordinary skill in the art of documents at the time the invention was made for the document to be a word processing document because word processing is prepared in clearly worded, readable text without an elaborate design or typography.

With respect to claim 8, Zarmer nor Fujisawa teaches, the document is an e-mail message, but it would have been obvious to one having ordinary skill in the art of documents at the time the invention was made for the document to be an e-mail message because e-mail documents are much more convenient than ordinary mail or telephone calls since it arrives immediately but doesn't require a recipient to be present.

With respect to claim 10, Zarmer nor Fujisawa teaches, the first format is an HTML format, but it would have been obvious to one having ordinary skill in the art of formats at the time the invention was made for the document to be in HTML format because HTML (Hypertext Markup Language) is a set of codes that can be inserted into text files to indicate special features such as typefaces, inserted images and links to other hypertext documents on the Internet and almost any word processor or page layout can be used to produce HTML.

Claims 11-28 and 30-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zarmer and Fujisawa and further in view of Malone et al (5,727,175), hereafter Malone.

With respect to claim 11, Zarmer nor Fujisawa teaches, the second format comprises a data field. Malone teaches this in **column 5, lines 2-16**. It would have been obvious at the time the invention was made to one having ordinary skill in the art of second formats to have a data field and to combine Zarmer's first format and Fujisawa's first image format with Malone's second format comprising a data field because the field contains a "single fact" of data information relating to the document.

With respect to claim 12, Zarmer nor Fujisawa teaches, a data field containing a file name. Malone teaches this in **column 7, lines 8-15 and column 9, lines 29-49**. It would have been obvious at the time the invention was made to one having ordinary skill in the art of data fields to have a file name and to combine Zarmer's hierarchy of folders and Fujisawa's text format with Malone's data field containing a file name because the contents of a data field contains a "single fact" relating to the name the user gave the file for later retrieval.

With respect to claim 13, Zarmer, Fujisawa, nor Malone teaches, the data field contains the memory location, but it would have been obvious at the time the invention was made to a person of ordinary skill in the art of memory locations to have a data field because information while being worked on is stored in the memory.

With regard to claim 14, Zarmer nor Fujisawa teaches, the data field contains a bit map.

Malone teaches this in **column 6, lines 18-33**. It would have been obvious at the time the invention was made to one having ordinary skill in the art of data fields to have a bit map and to combine Zarmer's data structure and Fujisawa's image format with Malone's data field containing a bit map because bitmaps have the capability of being imported into other application programs such as word processing programs.

With respect to claims 15 and 27, Zarmer, Fujisawa, nor Malone teaches, the data field contains raw text, but it would have been obvious at the time the invention was made to one having ordinary skill in the art of raw text to have a data field because the raw text is information waiting to be processed by a user.

With respect to claim 16, Zarmer nor Fujisawa teaches, the data field contains a data attribute. Malone teaches this in **column 18, lines 40-49**. It would have been obvious to one having ordinary skill in the art of data attributes at the time the invention was made to have a data field and to combine Zarmer's extraction of attribute data and Fujisawa's text format with Malone's data field containing a data attribute because the attributes can customize which paragraphs are displayed for a document in a hierarchical tree-structure.

With respect to claims 17 and 35, Zarmer nor Fujisawa teaches, the data attribute is an author name. Malone teaches this in **column 13, lines 51-63, column 15, lines 24-38, and figures 4 and 15**. It would have been obvious to one having ordinary skill in the art of data attributes at the time the invention was made for the attribute to be an author name and to combine Zarmer's electronic document and Fujisawa's first format with Malone's author's name being a data attribute because the attribute customizes the name of the sender of an e-mail message.

With respect to claim 18, Zarmer nor Fujisawa did not teach, the data attribute is a publication date. Malone teaches this in **column 13, lines 6-20 and column 16, lines 31-47**. It would have been obvious to one having ordinary skill in the art of publication dates at the time the invention was made for the attribute to be a publication date and to combine Zarmer's attribute data and Fujisawa's text format with Malone's data attribute being a publication date because the user can perform a faster search through a document collection to find when the document was first published by the author.

With respect to claim 19, Zarmer, Fujisawa, nor Malone teaches, the data attribute is a word count, but it would have been obvious to one having ordinary skill in the art of data attributes at the time the invention was made to have a word count because a document is formatted according to the number of words contained in the text of the word processing document that will fit on a page.

With respect to claim 20, Zarmer, Fujisawa, nor Malone teaches, the data attribute is an annotation, but it would have been obvious to a person of ordinary skill in the art of annotations at the time the invention was made for the data attribute to be an annotation because an annotation is used as an attachment to part of a document that provides a comment or explanation related to the document contents.

With respect to claims 21 and 37, Zarmer nor Fujisawa teaches, the data attribute is a keyword. Malone teaches this in **column 10, lines 4-40**. It would have been obvious to one having ordinary skill in the art of using keywords at the time the invention was made to have a data attribute and to combine Zarmer's collection of documents and Fujisawa's text format with Malone's keyword being a data attribute because keywords have a special meaning when performing searches. For example, the U.S. Patent Office's automated search and retrieval system uses keywords for searching and retrieving information and related documents.

With respect to claim 22, Zarmer nor Fujisawa teaches, the data attribute is an image type. Malone teaches this in **column 19, lines 6-26**. It would have been obvious to one having ordinary skill in the art of image types at the time the invention was made to have a data attribute and to combine Zarmer's first document format and Fujisawa's

image format with Malone's image type being a data attribute because the attribute of the image in word processing and graphics programs can be a thumbnail (often referred to as a thumbprint) of a document designed to fit in the corner of the computer screen.

With respect to claim 23, Zarmer nor Fujisawa teaches, the data attribute is an image dimension. Malone teaches this in **column 20, lines 8-18**. It would have been obvious to one having ordinary skill in the art of image dimensions at the time the invention was made to have a data attribute that is an image dimension and to combine Zarmer's data structure and Fujisawa's first format being an image format with Malone's image dimension being a data attribute because in word processing and graphics programs a document image can be sized to be either full-scale or to be a thumbnail (thumbprint) of the document.

With respect to claim 24, Zarmer, Fujisawa, nor Malone teaches, the data attribute is meta-text with positioning information, but it would have been obvious to one having ordinary skill in the art of meta-text at the time the invention was made to have positioning information because meta-text refers to the attributes of a document and identifies where the document is to be located in the hierarchical document collection.

With respect to claim 25, Zarmer, Fujisawa, nor Malone teaches, extracting indexing information from the attribute data in the data structure, but it would have been obvious to one having ordinary skill in the art of extracting indexing information at the time the invention was made to have a data structure because documents in a document collection have stored attributes relating to the document.

With respect to claim 26, Zarmer, Fujisawa, nor Malone teaches, monitoring modifications to the document, extracting updated indexing information, and updating the attribute data contained in the data structure based on the updated indexing information, but

it would have been obvious to one having ordinary skill in the art of document modifications at the time the invention was made to extract the updated indexing information and to update the attribute data because in an indexing database a comparison is made of the search terms initiated by a user.

With respect to claim 28, Zarmer nor Fujisawa teaches, identify the document from other documents in the document collection utilizing the indexing information.

Malone teaches this in **column 1, lines 52-67 and column 2, lines 1-2**. It would have been obvious to one having ordinary skill in the art of document identification at the time the invention was made to combine Zarmer's hierarchy of electronic folders and Fujisawa's file name with Malone's indexing information because the indexing database stores the keywords or attributes that are associated with the documents in the document collection.

With respect to claim 30, Zarmer, Fujisawa, nor Malone teaches, electronically analyzing the attribute data stored in the data structure corresponding to the document and determining whether the document is to be automatically linked to the first electronic folder, based on the electronic analysis of the attribute data stored in the data structure, but it would have been obvious to a person of ordinary skill in the art of analyzing data attributes at the time the invention was made to have a stored data

structure because for example, in Lotus Notes and Microsoft Windows '98 a user can generate the data from document storage and depending on the document contents the user can decide whether to link the folder to the next folder in the hierarchy.

With respect to claim 31, Zarmer, Fujisawa, nor Malone teaches, identifying the document on an inclusion list if it is determined that the document is not automatically linked to the first document, but it would have been obvious to a person of ordinary skill in the art of document identification at the time the invention was made to have an inclusion list because the list identifies documents that are excluded during the categorization process and are not associated with an electronic folder.

With respect to claims 32 and 33, Zarmer nor Fujisawa teaches, monitoring the document modifications. Malone teaches this in **column 3, lines 63-67 and column 4, lines 1-55**. It would have been obvious to one having ordinary skill in the art of document modifications at the time the invention was made to monitor the modifications and to combine Zarmer's attribute data and Fujisawa's electronic document importing with Malone's monitoring document modifications because the user can change the document data by making additions or deletions to the document contents.

With respect to claim 33, Zarmer, Fujisawa, nor Malone teaches, Automatically linking the document to a second electronic folder if a document modification causes the attribute data to match a set of predefined criteria corresponding to the second electronic folder, but it would have been obvious to a person of ordinary skill in the art of document linking at the time the invention was made to match the predefined criteria

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because if a user modifies the contents of the document this will change the users created links to the folders in the hierarchy.

With respect to claim 34, Zarmer nor Fujisawa teaches, the attribute data is a document title. Malone teaches this in **column 25, lines 2-31 and figure 2 (document entitled “BUG FIX REQUEST”)**. It would have been obvious to one having ordinary skill in the art of document modifications at the time the invention was made to have a document title and to combine Zarmer’s first format and Fujisawa’s file name with Malone’s document title because the document has the attributes associated with the title or heading of the e-mail messages.

With respect to claim 36, Zarmer nor Fujisawa teaches, the attribute data is a phrase associated with the document. Malone teaches this in **column 21, lines 50-63, column 28, lines 37-57, and figure 16**. It would have been obvious to one having ordinary skill in the art of phrases at the time the invention was made to have the phrase associated with the document and to combine Zarmer’s data structure and Fujisawa’s text format with Malone’s attribute data because the attribute data is a fragment corresponding to the document in the indexing database storage.

With respect to claim 38, Zarmer, Fujisawa, nor Malone teaches, the data attribute is a common concept, but it would have been obvious to one having ordinary skill in the art of common concepts at the time the invention was made to have a data attribute because a search allows a user to retrieve documents matching the attribute data including text, metadata and the format of the document in the collection.

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With respect to claim 39, Zarmer, Fujisawa, nor Malone teaches, automatically manipulating the document based on a predefined behavior associated with the first electronic folder, but it would have been obvious to one having ordinary skill in the art of document manipulation at the time the invention was made to have a first electronic folder because a user can program a folder with particular characteristics relating to the folder contents.

With respect to claims 40 and 44, Zarmer nor Fujisawa teaches, the predefined behavior is user-defined behavior. Malone teaches this in **column 3, lines 26-67 and column 4, lines 1-55**. It would have been obvious to one having ordinary skill in the art of user-predefined behavior at the time the invention was made to have user-defined behavior and to combine Zarmer's data structure and Fujisawa's data attributes with Malone's predefined behavior because the user can program the folder to perform certain functions when the documents are linked to a hierarchical folder in a managed document collection.

With respect to claims 41 and 45, Zarmer nor Fujisawa teaches, the predefined behavior involves e-mailing the document to a preprogrammed e-mail address. Malone teaches this in **column 11, lines 42-64 and column 12, lines 53-60**. It would have been obvious to one having ordinary skill in the art of predefined behavior at the time the invention was made to e-mail a document to a preprogrammed e-mail address and to combine Zarmer's electronic document and Fujisawa's image format with Malone's preprogrammed e-mail address because the user has the capability to e-mail all of the

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documents that are stored in a folder to a particular recipient's e-mail address. This can be performed in Lotus Notes cc: Mail or any other e-mail program.

With respect to claims 42 and 46, Zarmer, Fujisawa, nor Malone teaches, the predefined behavior involves providing controlled access to the document, but it would have been obvious to a person of ordinary skill in the art of predefined behavior at the time the invention was made to have controlled access because a user has the capability to program the folder according to the users specifications.

With respect to claim 43, Zarmer, Fujisawa, nor Malone teaches, linking the document to a folder, ... and automatically manipulating the document according to the predefined behavior, but it would have been obvious to one having ordinary skill in the art of document manipulation at the time the invention was made to have a folder and to manipulate it automatically because certain tasks are performed when the documents are linked to folder which are initiated by the user.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Patentability shall not be negated by the manner in which the invention was made.

Claim 51 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zarmer et al (US 5,625,818), hereafter Zarmer.

With respect to claim 51, importing a document into a collection of documents in a computer-based system, the collection of documents is organized within the computer-based system in according to a hierarchy of electronic folders (**column 6, lines 19-40**), storing the document in a memory location (**column 7, in particular lines 18-27, column 12, lines 41-48, and column 18, lines 17-23**), automatically extracting attribute data from the document (**column 18, lines 24-34**), generating a data structure corresponding to the document (**column 23, lines 40-51 and column 24, lines 48-63**), and linking the document to the first electronic folder (**column 9, lines 27-42 and column 6, lines 35-40**). Zarmer does not teaches, the extracted attribute data in a standardized format ..., and the data structure stored in memory separate from the document, predefining category criteria for a first electronic folder ..., but it would have been obvious to one ordinary skill in the art of extracted attribute data, data structures, and predefining category criteria at the time the invention was made to have a standardized format, a memory separate from the document, and a first electronic folder because the user has the capability to program the folder to a recognizable format according to the category and the placement of the document in the hierarchy.

(11) Examiner's response to Arguments:

Prior to providing individual responses to each of the arguments, the Examiner notes the following: The invention as claimed in each of the pending claims is directed to the management of a document collection comprising a hierarchy of electronic folders. Each of the references (Zarmer, Fujisawa, and Malone) applied in combination teaches the management of a collection of documents comprising a hierarchy of electronic folders. The Zarmer and Fujisawa references are classified in class 707, subclass 104, of the U.S. Patent classification system, one of the most relevant areas of search for a document collection with a hierarchy of folders to which the invention is directed.

For all of the issues please refer to the final rejections.

The following arguments are relevant:

In response to Appellants' argument no. 1, page 8, the last paragraph: ... automatically extracting of attribute data from the document ..."

Zarmer teaches document management by utilizing "ObjectMan," see col. 11, lines 13-37, and col. 12, lines 10-34. Persistence storage of document attributes is taught in col. 11. Also see col. 18, lines 23-34.

In response to Appellants' argument no. 2, page 10: "The Office Action fails to present a valid reason why one of ordinary skill in the art would be motivated to modify the teachings of Zarmer."

Zarmer teaches a document management system by implementing an object-oriented method to register documents and to store the document attributes in a persistent store

("ObjectMan" procedure; col. 11, lines 13-47, col. 12, lines 10-34; and col. 13, lines 21-22). Zarmer also creates a number of document folders (col. 23, line 40-57) by utilizing the ObjectMan procedure. Zarmer further suggests that folders be created for a variety of purposes (col. 23, lines 41-46) at users discretion.

Since the folders in Zarmer are object classes (see col. 23, lines 39-57), it is possible to designate the attributes of a method that instantiates a particular folder class. Therefore, with respect to claim 1, Zarmer does not explicitly indicate that a set of criteria be predetermined and matched to link an imported document to a particular folder as recited in claim 1. In other words, Zarmer does not explicitly indicate a method to link the imported documents in a folder. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to construct a folder for linking imported documents to avoid processing of the documents that are already registered in a database but process the ones that are imported or newly arrived and thus improve system performance. It would have been within the general knowledge of a person of ordinary skill to use a data, for instance today's date, as an attribute to do so.

The Appellants argument regarding the motivation is not persuasive because a suggestion/ motivation need not be expressly stated in one or all of the references used to show obviousness. *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985); *In re Scheckler*, 438 F.2d 999, 1001, 168 USPQ 716, 717 (CCPA 1971). It is assumed that every reference relies to some extent on the knowledge of persons skilled in the art to complement that which is disclosed

therein. Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established “from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference.” *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

In response to Appellants' argument no. 3 on page 12, B: Claim 51 is rejected for the same rationale used herein above in Argument 1 is applied to claim 1.

In response to Appellants' argument no. 4: C, D, E, F, G, H, I, and J on pages 16-24 : Appellants' argument that the combination of Zarmer, Fujisawa, and Malone do not disclose or suggest the steps of “automatically extracting attribute data from the document, generating a data structure in a second format independent of the first format, ... maintained in memory separate form the imported document,” and “linking the imported document Zarmer, Fujisawa, and Malone combined teach the claim limitations of claims 1-28, 30-46, and 51 or the claim limitations are well known in the art or obvious to one having ordinary skill in the art at the time the invention was made.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,



E. Colbert
May 4, 2001



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